

REMARKS

Claims 1, 2, 4-6, 8-12 and 14-19 remain pending in this application. Claims 3 and 7 have been canceled without prejudice or disclaimer. Claims 10-12 and 14-16 have been withdrawn from consideration as being directed to a non-elected invention.

Claims 4 and 8 have been amended to delete reference to canceled claim 3. Claims 1, 4, 5, 6, 8 and 9 have been amended to delete reference to the embodiment where the liquid may comprise a fluorine compound. Finally, claim 1 has been amended to point out that the photopolymer plate is made from a photopolymer. Support for this language can be found, for example, at Example 1 beginning at page 39, line 11 of the specification. Accordingly, no new matter has been introduced by these amendments.

Claims 1-9 and 17-19 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because the specification allegedly does not have support for a "photopolymer as a raw material." Applicants disagree because it would be apparent to a person skilled in the art that a photopolymer is used as a starting material in the production of a photopolymer plate according to the present invention. Nevertheless, claim 1 has been amended to more readily track the description at page 39 (Example 1) which illustrates that a photopolymer plate is made from a photopolymer composition. Accordingly, this rejection should be withdrawn.

Claims 1-9 and 17-19 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the recitation of the plate comprising a photopolymer as a raw material is allegedly unclear. Although the Examiner correctly points out that there is no explicit definition of raw material in the specification, it should

be apparent from the disclosure (e.g., Example 1 on page 39 of the specification) that a photopolymer is used when making the photopolymer plate of the present invention. Nevertheless, in order to advance prosecution of this application, claim 1 has been amended to delete reference to a "raw material" and to simply point out that the plate is made from a photopolymer. Accordingly, this rejection should be withdrawn.

Claims 1-9 and 17-19 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the claim allegedly uses improper Markush claim language. As noted in the response to the previous Office action, a Markush phrase is not required when reciting alternative embodiments. The Examiner has not pointed out why the recited language "selected from" is unclear or otherwise indefinite, but appears to be under the mistaken impression that language from the Markush decision is the only acceptable phrase. It should be noted that even MPEP 803.02 that addresses "Markush Claims" states that a Markush-type claim recites alternatives in a format such as "selected from the group consisting of A, B and C." Clearly the language used in *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925) is not mandatory and is not the only acceptable way to recite alternatives. We had a telephone conference with Examiner Robinson on Monday, March 14, 2011, to discuss this rejection only. Examiner Robinson maintained the rejection. Our efforts to talk with Supervisor Kelly were unsuccessful, but we were able to speak to Director Eyler who agreed that Markush language is not mandatory and is not the only acceptable way to recite alternatives. Accordingly this rejection should be withdrawn.

Claims 1-9 and 17-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuji (US2002/0182543 A1) in view of Wallbillich (U.S. Patent No.

4,876,118). The Examiner has acknowledged that Fuji does not explicitly disclose that the contact step brings the photopolymer plate into contact with a liquid comprising a silicone compound and/or a fluorine compound modified with a reactive functional group selected from the recited functional groups. The fluorine compound embodiment has been deleted from the claims as amended.

Fuji does disclose a developing liquid that may contain a silicone mixture as an anti-foaming agent, but does not otherwise describe the silicone compound. The Examiner relies on the teachings of Wallbillich as disclosing a gravure printing plate that is contacted with a liquid comprising a silicone compound modified with one or more functional groups (col. 3, lines 36-51) and/or a fluorine compound. However, the fluorine compound embodiment has been deleted from the claims as amended and the functional groups described in Wallbillich do not fall within the scope of claim 1. Since neither Fuji nor Wallbillich describe a silicone compound having a functional group falling within the scope of claim 1, it is clear that neither Fuji nor Wallbillich, alone or in combination, can teach or suggest a method according to the claimed invention. In addition, the Examiner has not suggested any reason for modifying the teachings of either Fuji and/or Wallbillich in a manner that would lead to the claimed invention. Accordingly, this rejection should be withdrawn.

Prompt and favorable reconsideration is requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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